Docket No. J&J5133

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Muriel Morelli

Confirmation No.: 2082

Application No.: 10/529,702

Group No.: 1618

Filed: July 11, 2006

Examiner: N. Westerberg

For: **THICKENER COMPOSITIONS**

I hereby certify that this correspondence is electronically transmitted to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

October 4, 2010

(Date)

James P. Barr

Name of applicant, assignee, or Registered Representative

/James P. Barr/

(Signature)

October 4, 2010

(Date of Signature)

Commissioner for Patents
P.O. Box 1450
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APPEAL BRIEF

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I. Real Party in Interest

The real party in interest is Johnson & Johnson Consumer Companies, Inc., the assignee of the application.

II. Related Appeals and Interferences

None.

III. Status of the Claims

Claims 1-3 and 6-8 are pending and have been finally rejected in the Office Action mailed April 29, 2010 ("Final Office Action").[1] Claims 4, 5 and 9 have been canceled. Claims 1-3 and 6-8 are on appeal.

[1] On April 22, 2009, the Examiner set forth an election of species requirement ("Election of Species") requiring Appellants to elect "the inclusion of and type of electrolyte." On May 22, 2010 Appellants filed a Response to Restriction Requirement ("Response to Restriction") wherein Appellants elected, with traverse, a mixed glycolate/citrate salt of dimethylethanol amine.

IV. Status of Amendments

On July 29, 2010 Appellants filed an After-Final Amendment ("After-Final Amendment") attempting to cancel the non-elected subject matter of claim 8 and place the Application in better form for appeal by incorporating the limitations of claim 6 into claim 1 in an effort to address the Examiner's 35 U.S.C. §112 rejection of claim 6. In the Advisory Action mailed August 9, 2010, the Examiner denied entry of the After Final Amendment arguing that the amendment raised new issues and would require further consideration and search. Specifically, the Examiner states that the particular ingredient and amount was not previously presented in the claims. Appellants respectfully disagree. No amendment to the amount of ingredients was made. Further, claim 6 was previously presented and therefore the incorporation of the limitations thereof into claim 1 would not raise new issues. Nevertheless, the Examiner denied entry of the After-Final Amendment.

V. Summary of Claimed Subject Matter

The claimed invention is directed to a chemical composition comprising:

(a) from 0.005 to 3 wt.% of sclerotium gum;

(b) from 0.005 to 3 wt.% of a copolymer

(c) an aqueous carrier; and

(d) at least 0.5 wt.% of at least one electrolyte.

Specification, page 4, lines 26-31; page 5, lines 6-7, page 6, lines 28-30; and page 13, line 27 – page 14, line 10.

The pH of the composition ranges from about 4.5 to about 8. Specification, page 5, lines 6-7. The copolymer is selected from the group consisting of methyl vinyl ether/ maleic anhydride copolymer and acryloyldimethyltaurate vinylpyrrolidone copolymer. See Specification page 6, lines 8-24.

On April 22, 2009, the Examiner set forth an election of species requirement ("Election of Species") requiring Appellants to elect "the inclusion of and type of electrolyte." On May 22, 2010 Appellants filed a Response to Restriction Requirement ("Response to Restriction") wherein Appellants elected, with traverse, a mixed glycolate/citrate salt of dimethylethanol amine (Specification, page 11, lines 17-25) as the electrolyte.

As discussed in the Specification, Applicants have discovered that thickened compositions containing higher levels, e.g., at least 0.5 wt.%, of electrolyte, i.e., ethanolamine derivatives, with acceptable stability and sufficiently long shelf life can surprisingly be obtained through the use of a combination of sclerotium gum and a copolymer selected from the group consisting of methyl vinyl ether/ maleic anhydride copolymer and acryloyldimethyltaurate vinylpyrrolidone. See Specification, page 9, lines 16-20, page 11 lines 16-25, and page 13, lines 26-32; and page 14, lines 1-9. Such a thickened composition is neither taught nor suggested by any of the references relied upon by the Examiner.

VI. Grounds of Rejection To Be Reviewed On Appeal

A. Whether Claim 6 is indefinite under 35 U.S.C. § 112, second paragraph.

B. Whether Claims 1-3 and 6 are unpatentable under 35 U.S.C. § 103 in view of U.S. Published Patent Application No. US2003/0007985 ("Chevalier et al.") and U.S. Patent No. 5,425,939 ("Guerrero et al.").

C. Whether claims 1-3 and 6-8 are unpatentable under 35 U.S.C. § 103(a) in view of U.S. Published Patent Application No. US2003/0007985 ("Chevalier et al."), U.S. Patent No. 5,425,939 ("Guerrero et al.") further in view of U.S. Patent No. 5,554,647 ("Perricone") and U.S. Patent No. 5,441,740 ("Ozlen").

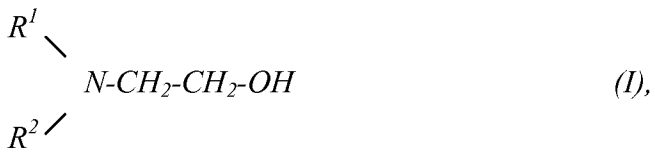
VII. Argument

A. Claim 6 Particularly Points Out And Distinctly Claims The Subject Matter Which Appellant Regards As The Invention

The Examiner has finally rejected claim 6 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. The Examiner argues that it is unclear if 0.5 wt.% total electrolytes must be present or 0.5 wt.% of electrolyte of formula I must be present. Appellants respectfully disagree.

For convenience, claim 6 is reproduced below:

6. A composition according to claim 1, wherein the electrolyte is at least one ethanolamine derivative of formula I, or a topically acceptable salt thereof:



(I),

wherein in formula I, R^1 and R^2 independently represent hydrogen, C_{3-6} cycloalkyl or C_{1-6} alkyl, optionally substituted with hydroxy, methoxy, oxo or formyl.

A claim is indefinite when it contains words or phrases whose meaning is unclear. Here, claim 6 depends on claim 1 and refers to "the electrolyte," and claim 1 contains an earlier recitation of electrolyte. Accordingly, it is clear that the limitation with respect to electrolyte of formula 1 is making reference to the electrolyte recited in claim 1. The scope of claim 6 would be reasonably ascertainable by those skilled in the art and is therefore not indefinite. Specifically, it is clear that claim 6 is further defining the electrolyte of claim 1 which is clearly present at "at least 0.5 wt.%." Appellant notes that an attempt was made to address the Examiner's concerns by canceling claim 6 and

incorporating the limitations thereof into claim 1. However, the Examiner denied entry. In any case, for the reasons of record and discussed above, Appellant maintains that claim 6 particularly points out and distinctly claims the subject matter which appellant regards as the invention. Accordingly, Appellant respectfully requests that this rejection be reversed.

B. Claims 1-3 and 6 Are Patentable Over U.S. Published Patent Application No. US2003/0007985 ("Chevalier et al.") and U.S. Patent No. 5,425,939 ("Guerrero et al.").

The Examiner has finally rejected claims 1-3 and 6 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application No. US2003/0007985 ("Chevalier et al.") in view of U.S. Patent No. 5,425,939 ("Guerrero et al."). Appellants respectfully request reversal of this rejection.

As discussed in the Specification, Applicants have discovered that thickened compositions containing higher levels, e.g., at least 0.5 wt.%, of electrolyte, i.e., ethanolamine derivatives, with acceptable stability and sufficiently long shelf life can surprisingly be obtained through the use of a combination of sclerotium gum and a copolymer selected from the group consisting of methyl vinyl ether/ maleic anhydride copolymer and acryloyldimethyltaurate vinylpyrrolidone. See Specification, page 9, lines 16-20, page 11 lines 16-25, and page 13, lines 26-32; and page 14, lines 1-9.

Indeed, the present invention relates to a chemical composition comprising: (a) from 0.005 to 3 wt.% of sclerotium gum; (b) from 0.005 to 3 wt.% of a copolymer selected from the group consisting of methyl vinyl ether/ maleic anhydride copolymer and acryloyldimethyltaurate vinylpyrrolidone copolymer; (c) an aqueous carrier; and (d) at least 0.5 wt.% of at least one electrolyte, wherein the pH of the composition ranges from about 4.5 to about 8.

None of the references relied upon by the Examiner, taken alone or in combination, teach or suggest the presently claimed thickened composition comprising at

least 0.5 wt.% of an electrolyte, much less, the elected electrolyte of mixed glycolate/citrate salt of dimethylethanolamine.

The Examiner relies upon Chevalier et al. as disclosing compositions with an anti-wrinkle effect in a physiologically acceptable aqueous medium. Specifically, the Examiner relies upon Example 2 as disclosing an anti-aging serum comprising 0.2% xanthan gum, 0.2% PVM/MA decadiene crosspolymer, water and 0.2% triethanolamine. There is no teaching or suggestion of the incorporation of at least 0.5% of an electrolyte, much less, the elected electrolyte of mixed glycolate/citrate salt of dimethylethanolamine. Further, there is no teaching or suggestion of the incorporation of sclerotium gum.

Recognizing that Chevalier et al. does not teach or suggest the inclusion of sclerotium gum, the Examiner relies upon Guerrero et al. The Examiner argues that because Guerrero et al. teaches that the use of sclerotium gum in combination with a hydrophobically-modified (meth)acrylate polymer forms an effective thickening system for cosmetic compositions it would have been obvious to one of ordinary skill in the art to incorporate the 2-part thickening system of sclerotium gum and hydrophobically-modified (meth)acrylate polymer to the anti-aging composition of Chevalier et al. to be used as a thickener in addition to one of the suggested gelling agents, lipophilic gelling agent PVM/MA. Appellant respectfully disagrees.

As noted by the Examiner, Guerrero et al. teaches that many thickeners are known but not all thickening agents are equally effective for any particular type of formulation. See col. 1, lines 21-24. There is absolutely no teaching or suggestion in Guerrero et al. that the two part thickening composition of Guerrero et al. could be used in combination with the gelling agents taught by Chevalier et al., much less the specific lipophilic gelling agent PVM/MA. In fact, in light of the specific discussion in Guerrero et al. that "not all thickening agents are equally effective for any particular type of formulation" one of ordinary skill in the art would not expect that the incorporation of the two part thickening system of Guerrero et al. would be successful in the particular compositions taught by Chevalier et al.

The Examiner argues that it would have been obvious to include the 2-part thickening system of Guerrero et al. comprising sclerotium gum and a **hydrophobically**

modified acrylate or methacrylate copolymer as the **hydrophilic** gelling agent in the compositions of Chevalier et al. in order to provide effective thickening (Final Office Action, page 5). Appellants respectfully disagree. Why would one of ordinary skill in the art incorporate an ingredient known to have hydrophobic (water-hating) properties into a composition in order to replace a hydrophilic (water-loving) ingredient?

Further, Guerrero et al. fails to remedy the deficiencies of Chevalier et al. in that there is no teaching or suggestion to increase the amount of triethanolamine (which Appellant presumes the Examiner is relying on as electrolyte) to at least 0.5 wt.%. In the Final Office Action, the Examiner states that she interprets claim 6 as not requiring 0.5 wt.%. Appellant respectfully disagrees with this interpretation. First, claim 1 clearly recites "at least 0.5 wt% of at least one electrolyte" and in response to the Examiner's election of species requirement, Appellant elected a mixed glycolate/citrate salt of dimethylethanolamine as the electrolyte in claim 1. Claim 6 depends on claim 1 and refers to "the electrolyte" of claim 1. Accordingly, it is clear that the limitation with respect to electrolyte of formula 1 is making reference to the electrolyte recited in claim 1. Therefore, it is clear that claim 6 is further defining the electrolyte of claim 1 to be of formula 1 which is clearly present at "at least 0.5 wt.%."

For the reasons of record and discussed above, there is no teaching or suggestion in either of the Chevalier or Guerrero references to modify the Chevalier compositions by incorporating sclerotium gum, increasing the amount of triethanolamine, and replacing the triethanolamine with the elected mixed a mixed glycolate/citrate salt of dimethylethanolamine. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness and the rejection should be reversed.

C. Claims 1-3 and 6-8 Are Patentable Over U.S. Published Patent Application No. US2003/0007985 ("Chevalier et al."), U.S. Patent No. 5,425,939 ("Guerrero et al.") In View of U.S. Patent No. 5,554,647 ("Perricone") and U.S. Patent No. 5,441,740 ("Ozlen").

The Examiner has finally rejected claims 1-3 and 6-8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application No. US2003/0007985 ("Chevalier et al.") and U.S. Patent No. 5,425,939 ("Guerrero et al.") as applied to claims 1-6 and 10 and further in view of U.S. Patent No. 5,554,647 ("Perricone") and U.S. Patent No. 5,441,740 ("Ozlen").

The Examiner relies upon Perricone as disclosing that "Dimethylaminoethanol (Dimethylethanolamine) is a precursor of acetylcholine that can be applied topically to treat aging skin" and relies upon Ozlen as disclosing "a topical composition for the treatment and alleviation of various skin conditions such as wrinkles that comprises both glycolic and citric acids." According to the Examiner, it would have been obvious to incorporate dimethylethanolamine, glycolic acid and citric acid into a cosmetic composition because "each of these ingredients is taught as useful for the treatment of wrinkling, aging skin by the prior art" (December 2, 2002, Non-Final Office Action, page 10). Appellant respectfully disagrees.

Perricone and Ozlen, taken alone or in combination, fail to remedy the deficiencies of Chevalier et al. and Guerrero et al. discussed above. Specifically, there is no teaching or suggestion to increase the amount of triethanolamine (electrolyte) to at least 0.5 wt.% and nor is there any teaching or suggestion to incorporate sclerotium gum into the Chevalier et al. anti-aging serum.

In the Final Office action, the Examiner states that "none of the claims require that triethanolamine be present at 0.5%" (Final Office Action, page 6). Appellant assumes that the Examiner is taking the position that the triethanolamine of Chevalier's Example 2 is an electrolyte. Present claim 1 clearly recites "at least 0.5 wt.% of at least one electrolyte." Accordingly, the Examiner's statement is confusing. The Examiner's remarks, however, point out another deficiency of this rejection. There is no teaching or suggestion that the acetylcholine precursors of Perricone in combination with the glycolic

and citric acids of Ozlen could successfully replace the triethanolamine present in Example 2 of Chevalier or that the amount should or even could be increased to 0.5 wt.%.

With respect to claim 8, Appellant notes that although claim 8 is included in this rejection, the Examiner has not set forth reasons why claim 8 is obvious in view of Chevalier, Guerrero, Perricone and/or Olzen. There is no teaching or suggestion in any of the references relied upon by the Examiner that a vitamin C salt would be useful as an electrolyte in an amount of at least 0.5wt.% in the Chevalier compositions. Further, in response to the Examiner's election of species requirement, Appellant elected, with traverse, a mixed glycolate/citrate salt of dimethylethanolamine as the electrolyte which claim 8 does not relate to. Appellant attempted to cancel claim 8 in the After-Final Amendment, however, the Examiner denied entry.

For the reasons of record and as discussed above, none of the references relied upon by the Examiner, taken alone or in any combination, teach or suggest a composition containing at least 0.5 wt.% of at least one electrolyte in combination with sclerotium gum and the recited copolymer. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness and the rejection should be reversed.

Respectfully submitted,

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VIII. Claims Appendix

1. A chemical composition comprising:

(a) from 0.005 to 3 wt.% of sclerotium gum;

(b) from 0.005 to 3 wt.% of a copolymer selected from the group consisting of methyl vinyl ether/ maleic anhydride copolymer and acryloyldimethyltaurate vinylpyrrolidone copolymer;

(c) an aqueous carrier; and

(d) at least 0.5 wt.% of at least one electrolyte, wherein the pH of the composition ranges from about 4.5 to about 8.

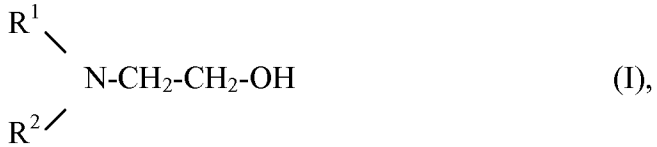
2. A chemical composition according to claim 1, wherein said copolymer is an ammonium salt of acryloyldimethyltaurate vinylpyrrolidone copolymer.

3. A chemical composition according to claim 1 comprising:

from 0.005 to 1 wt. % of said sclerotium gum and

from 0.005 to 1 wt. % of said copolymer.

6. A composition according to claim 1, wherein the electrolyte is at least one ethanolamine derivative of formula I, or a topically acceptable salt thereof:



(I),

wherein in formula I, R^1 and R^2 independently represent hydrogen, C_{3-6} cycloalkyl or C_{1-6} alkyl, optionally substituted with hydroxy, methoxy, oxo or formyl.

7. A formulation according to claim 6 wherein the ethanolamine of formula I is a mixed glycolate/citrate salt of dimethylethanolamine.

8. A formulation according to claim 1, wherein the electrolyte is a Vitamin C salt.

IX. Evidence Appendix

None.

X. Related Proceedings Appendix

None.